

Appl. No. 10/645,764
Resp. dated October 25, 2004
Reply to Office Action of October 1, 2004

REMARKS

Applicant has carefully reviewed the Office Action dated October 1, 2004, regarding the above-referenced patent application. Claims 1-25 are pending in the application, wherein claims 1-25 are under a restriction requirement. The Examiner requests restriction to a single invention, citing three distinct inventions: (I) claims 1-9 drawn to a catheter braid; (II) claims 10-19 drawn to a catheter; and (III) claims 20-25 drawn to a method of forming a catheter. Applicant respectfully traverses this restriction requirement.

The Examiner asserts that Inventions II and I are related as combination and subcombination. Applicant agrees with this assessment. However, in order to support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary. (See M.P.E.P. § 806.05(c).) Applicant disagrees with the Examiner's assertion that the combination and subcombination are distinct. Inventions are distinct if it can be demonstrated that: (A) the subcombination can be shown to have utility by itself or in other and different relations, and (B) the combination as claimed does not require the particulars of the subcombination as claimed for patentability. (See M.P.E.P. § 806.05(c).) The Examiner stated in the Office Action, "In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the braid does not set forth the particulars of the catheter." (Emphasis added.) Applicant asserts that this statement is in error. The braid is a subcombination of the catheter; therefore, it must be shown that the combination (the catheter) does not require the particulars of the subcombination (the braid) in order to show that the inventions are distinct.

Applicant asserts that the combination as claimed in claim 10 does require the particulars of the subcombination as claimed in claim 1. A careful comparison of the claims written to the combination and subcombination reveals that all of the elements of the catheter braid recited in claim 1 are included in describing the braid layer of the catheter in claim 10. The following table is a side-by-side comparison of the elements of claims 1 and 10.

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Claim 1	Claim 10
	A catheter having a distal end and a proximal end, the catheter having a distal region proximate the distal end, the catheter comprising:
	an inner layer extending from the distal end to the proximal end; and
A catheter braid formed from at least two continuous wires woven together, the catheter braid comprising:	a reinforcing braid layer disposed over the inner layer, the braid layer formed from at least two continuous wires woven together,
a proximal braid section in which each of the continuous wires has a proximal cross-sectional area; and	the braid layer comprising a proximal braid section in which each of the continuous wires has a proximal cross-sectional area,
a distal braid section in which each of the continuous wires has a distal cross-sectional area;	and a distal braid section in which each of the continuous wires has a distal cross-sectional area;
wherein for each continuous wire, the distal cross-sectional area of said continuous wire is less than the proximal cross-sectional area of said continuous wire.	wherein the distal cross-sectional area of each of the continuous wires is less than the proximal cross-sectional area of each of the continuous wires.

As shown in the above table, all of the elements of claim 1 are included in claim 10. Additionally, the only additional elements presented in the combination claim are a catheter with an inner layer extending from the distal end to the proximal end of the catheter. Applicant concedes that these elements are unpatentable without the details of the subcombination as claimed in claim 1. Therefore, the combination does require the particulars of the subcombination as claimed for patentability. When it cannot be shown that the combination does not require the particulars of the subcombination as claimed for patentability, such inventions are not distinct. (See M.P.E.P. § 806.05(c).)

Because the combination and subcombination are not distinct, Applicant asserts that a restriction between invention I and II is unwarranted. Applicant respectfully requests withdrawal of this restriction requirement. In requesting such withdrawal, Applicant would be willing to

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withdraw claims 20-25 drawn to a method of forming a catheter in view of the Examiner's remarks regarding Invention III. Therefore, Applicant respectfully requests examination of claims 1-19, while withdrawing claims 20-25 from consideration.

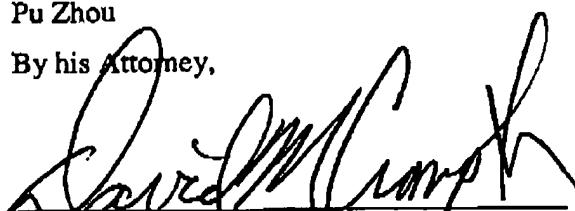
However, in case the Examiner disagrees with Applicants' above remarks, adhering to the requirement of 37 C.F.R. § 1.143 that a complete reply requires an election, Applicant hereby makes a provisional election to prosecute Invention I corresponding to claims 1-9. Nonetheless, in order to preserve the right of petition under 37 C.F.R. § 1.144, Applicant respectfully asserts that the restriction requirement is not warranted in view of the above remarks at least to Inventions I and II.

Examination of the above-identified claims is respectfully requested. If a phone conference is believed necessary to resolve any outstanding issues with respect to the above discussion, the Examiner is respectfully requested to contact the undersigned attorney.

Respectfully submitted,

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By his Attorney,



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